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IN THE

Supreme Court of the United States

October Term, 1970

No. 1140

THE D. S. BROWN COMPANY and
DELMONT D. BROWN,

Petitioners,

vs.

ACME HIGHWAY PRODUCTS CORPORATION,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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Petitioners have requested this Court to grant a writ of certiorari to review that part of the order of the Court below which held that to establish the defense of co-inventorship in the accused infringer, clear and convincing evidence was required.

Statement[1]

The Sixth Circuit held that the patent upon which Respondent (Acme Highway Products Corporation) had brought this action, is valid on the ground that the invention was a significant improvement over the prior art, and in the words of the District Court, "an accomplishment hitherto unheard of." (A 11).[2]

In holding the patent valid, the Court reversed the District Court in finding the patent invalid for public use (A 22); and reversed the District Court in finding Co-Petitioner, D. S. Brown, a co-inventor based on a "preponderance of the evidence" (A 23).

In the petition, Petitioners seek review of that part of the order, specific to the burden of proof necessary to establish coinventorship in an infringer who alleges coinventorship as a defense to the action. They request this Court to decide that as a matter of law, only a preponderance of evidence be sufficient to satisfy the burden, irrespective of the equities or postures of the parties.

We respectfully submit the petition is contrary to logic, equity and *all* of the existing law as expressed by the several Circuits, and by this Court, and should be denied.

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1. Respondent does not accept Petitioners' statements and characterization of the record, devoid of record references; but since the merits of the Petition are not affected, Respondent does not burden this Brief in Opposition by a detailed statement.

2. Reference is to the Appendix attached to the Petition.

Reasons for Opposition

Petitioners advance two arguments in support of their petition. The first is that the Court below erroneously "summarily" reversed the judgment of the trial court on the issue of inventorship; and, second, that the Court of Customs and Patent Appeals has held a preponderance of evidence sufficient, under 35 U.S.C. 116, 256, to correct a misjoinder or non-joinder of inventorship. The first argument is simply wrong, and the second is misplaced.

The Court below did not "summarily" reverse, but simply stated, after an extensive discussion of the facts and the law regarding public use, that,

> "The remaining issues on appeal may be disposed of summarily. All depend upon a determination whether Brown was a joint inventor * * *. Finding that he was not, we need not reach the issues of fraud upon the Patent Office or antitrust violations." (A 22, 23).

To place this issue in proper perspective, a brief review of the facts is necessary. The invention is directed to a resilient seal used for sealing joints in the pavements of roadways, bridges, and the like, having a unique internal configuration providing certain desirable characteristics (A 11). The seal, of course, must retain its resiliency during cold weather, and is, therefore, made of a suitable neoprene material.

The patentee, Mr. A. Crone, designed the seal, and had sketches made of his design long prior to the first meeting between Respondent and Co-Petitioner D. S. Brown. The Respondent, although in the business of manufacturing

highway products, was not an extruder of neoprene (A 16), and required the services of an extruder to produce the seal in accordance with Crone's design. Respondent obtained the name of Petitioners from the DuPont Company, manufacturer of neoprene (R 96, 97, 116-118).[1]

Prior to meeting with Respondent, Petitioners had no knowledge of road seals or their designs, or of any other highway products (R 122).

Seals embodying Crone's design were produced by Petitioners for Respondent during 1960, installed, and found to be successful. A satisfactory business relationship ensued for a time, during which Petitioners requested:

1. permission to sell seals of Crone's design, and to pay Respondent a royalty (R 143, 698); and
2. an exclusive license to sell the seal, which was denied by Respondent.

Moreover, D. S. Brown was informed of the pending patent application during the existence of the amicable relationship but never made claim to inventorship (R 149, 150).

In 1963, the parties fell into disagreements. Respondent thereafter sought and found other extruders of neoprene, and Petitioners continued to manufacture and sell Crone's design for their own profit and gain (A 3).

The patent issued to Respondent in April 1965; thereafter negotiations for a license to Petitioners failed, and this action was instituted in April 1966.

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1. Reference is to Joint Appendix constituting the record on appeal below.

Despite the fact that Respondent had sketches of the patented design prior to the meeting with Petitioners, and Petitioners admitted that they had no experience with or knowledge about road seals or other highway products prior to that meeting, Petitioners asserted the defense that D. S. Brown was a coinventor with Crone.

At trial, Respondent introduced into evidence, dated sketches, diary entries, drawings, and other documentary and live testimonial evidence. Petitioners offered only the testimony of D. S. Brown, and a single letter written by D. S. Brown to Respondent which included a sketch of the seal. The sketch was dated long after Crone's sketches, long after the meeting with Respondent, and, in fact, is mentioned in Respondent's diary[1] as a design telephonically communicated by Respondent to D. S. Brown prior to the letter. The trial court simply disregarded all the documentary evidence of Respondent on the ground that,

> "A good deal of it was of a type that could easily be manufactured or altered to meet the necessities of proof, * * *." (A 23)

The trial court held,

> "The preponderance of the evidence leads to the conclusion that the final design * * * was the joint product * * * of D. S. Brown, Freel Bryan and Alfred S. Crone * * *." (A 23)[2]

The Circuit Court reversed the trial court in applying the "preponderance of evidence" rule, in the light of the

1. The diary entries were recorded by Respondent's witness F. Bryan long prior to this action.

2. The holding that Freel Bryan was also a coinventor was utterly confounding as neither party urged such contention.

facts and the equities (A 24). The Court recognized and reiterated the well established rule as follows:

> "The temptation for honest witnesses, who have worked years with a patentee to implement his ideas, to forget whose ideas they were, is very strong. For this reason, it has been well established that joint inventorship [in the accused infringer] must be proven by clear and convincing evidence. (Pointer v. Six Wheel Corporation, 177 F.2d 153, 157-158 (9th Cir. 1949), cert. denied, 339 U.S. 911, 70 S. Ct. 570, 94 L. Ed. 1338 (1950); Agawan Company v. Jordan, 7 Wall. 583, 19. L. Ed. 177 (1868); 1 Deller's Walker on Patents §§39-43 (2d ed. 1964). See Eibel Process Company v. Minnesota & Ontario Paper Company, 261 U.S. 45, 60, 43 S. Ct. 322, 67 L. Ed. 523 (1923); The Barbed Wire Patent (Washburn & Moen Mfg. Co. v. Beat 'Em All Barbed-Wire Co.), 143 U.S. 275, 284-285, 12 S. Ct. 443, 36 L. Ed. 154 (1891); Webster Loom Company v. Higgins, 105 U.S. 580, 581, 26 L. Ed. 1177 (1881). Since the Appellees did not advance clear and convincing proof of joint inventorship, they did not meet their burden."

We submit the law applied by the Circuit Court was in accord with the law earlier decreed by this Court, and uniformly applied by all the Circuits. We know of no exception, and none was cited by Petitioners.

The Court of Customs and Patent Appeals (CCPA) case cited by Petitioners in support of their second argument, *In re Searles*, 422 F.2d 431 (1970), is completely inapplicable and irrelevant. First, that case did not involve an infringer who, in his anxiety to escape liability, claimed inventorship in himself; it involved a procedural matter before the Patent Office. Searles desired to convert his patent application from sole to joint inventorship. The coin-

ventor, Lutz, and Searles filed a joint affidavit under 35 U.S.C. 116, alleging coinventorship generally. In the affidavit, however, each believed he was responsible for the suggestion of a particular material constituting one of the several elements of the invention, although both agreed that the application should be in their names jointly. The Patent Office considered the affidavit insufficient, not because of an unsatisfied burden of proof, but because of the equivocal allegation (422 F.2d 431, 434). The CCPA disagreed with the Patent Office, and held the affidavit was sufficient, primarily because both persons joined in requesting the Patent Office to convert the application from sole to joint. The fact that there was confusion as to who thought of one element in the invention, involving several elements, was not significant (422 F.2d 431, 437).

That case, therefore, is simply inapposite, and surely it is not support for the suggestion that a different rule of law is applied by the CCPA in regard to the burden on an infringer to prove the defense of inventorship in himself.

For the reasons stated, Respondent respectfully submits, that the Petition for Certiorari be denied.

Respectfully submitted,

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